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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,684	09/05/2003	Jeff Miller	HALB:045	8556

7590

07/21/2006

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No. 10/656,684	Applicant(s) MILLER ET AL.	
	Examiner Philip C. Tucker	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 2-5, 9-12 and 29-35 is/are allowed.
6) ☒ Claim(s) 1, 6-8, 13-15, 21, 23, 24 and 26-28 is/are rejected.
7) ☒ Claim(s) 16-20, 22 and 25 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/3/06, 5/16/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 16-20, 22 and 25 are objected to because of the following informalities:
In claim 16, line 4, the number "14" appears and should be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Dymond (4777200).

Dymond teaches an invert emulsion drilling fluid within the scope of the present invention, which comprises polymers such as 2-ethylhexyl acrylate and acrylic acid copolymer (see the examples and in particular example 3). The specified mineral oils used are synthetic, and contain paraffins and olefins. Since the fluids may be used as drilling fluids, the use of "consisting essentially of" cannot distinguish.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6-8, 13-15, 21, 23, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dymond (4777200).

Dymond teaches a drilling fluid within the scope of the present invention, used in drilling a subterranean formation (see the examples). Although Dymond does not specifically show an example of a drilling fluid without a fluid loss agent, the specification therein does not teach that one is necessary. The specification is clearly enabling of a drilling fluid without a fluid loss agent. The courts have held that inherent anticipation only requires an enabling disclosure, and not an actual reduction to practice (Smithkline Beechman v. Apotex 74 USPQ2d 1398).. Thus from the teaching of Dymond, such fluids inherently having the properties of the current invention would be enabled to one of ordinary skill in the art. To the extent that one could remotely argue that Dymond does not anticipate, it is well established that removing an ingredient or method step and it's intended function is obvious to one of ordinary skill in the art (In re Karlson 136 USPQ 184, In re Brown 108 USPQ 232). The removal of the fluid loss agent, is thus obvious to one of ordinary skill in the art, since the remaining fluid would still have utility as a drilling fluid.

5. Claims 2-5, 9-12 and 29-35 are allowable over the art of record.

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6. Applicant's arguments have been considered but are not deemed fully persuasive. With respect to claims 12, 16 and 30, and those dependent therefrom, such is distinguished by the teaching of the vinyl neodecanoate. With respect to Dymond, applicant has argued that the invention is not inherently anticipated therein. The specification of Dymond is clearly enabling of a drilling fluid without a fluid loss agent. The courts have held that inherent anticipation only requires an enabling disclosure, and not an actual reduction to practice (Smithkline Beechman v. Apotex 74 USPQ2d 1398).. Thus from the teaching of Dymond, such fluids inherently having the properties of the current invention would be enabled to one of ordinary skill in the art. If Dymond does not anticipate, it is well established that removing an ingredient or method step and it's intended function is obvious to one of ordinary skill in the art (In re Karlson 136 USPQ 184, In re Brown 108 USPQ 232). The removal of the fluid loss agent, is thus obvious to one of ordinary skill in the art, since the remaining fluid would still have utility as a drilling fluid. As shown in the example in applicant's specification, the omission of the fluid loss agent in the current invention leads to inferior fluid loss properties in the present invention, which is expected. The present claims are thus not seen as distinguishing from Dymond. Claim 28 is also not distinguished as suggested by applicant, since in using "consisting essentially of", such can only distinguish over fluids which cannot be used as drilling fluids, which is not the case with Dymond.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

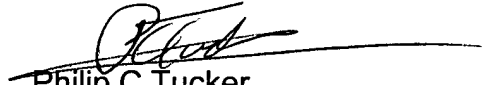
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-4005